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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,907	08/25/1999	TIMOTHY M. KEISER	10269/11	5840

29858 7590 05/09/2002

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT PAPER NUMBER

3623

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

BA

Office Action Summary

Application No.

09/382,907

Applicant(s)

KEISER ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 15-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION-Application # 09/382907

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to Including Fund Transfer or Credit Transaction, classified in class 705, subclass 39.
- II. Claims 15-27, drawn to Trading, Matching or Bidding, classified in class 705, subclass 37.
- III. Claims 28-41, drawn to Cost/Price, classified in class 705, subclass 400.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as using a computerized arrangement to transfer funds by debiting one account and crediting another by the same amount. In particular, invention I measures an imbalance between buy/sell orders, computes a projected price movement based on the imbalance, and then sets a market price based on the buy/sell orders and the imbalance. Invention II has separate utility such as using a computerized arrangement for planning the disposition or use of funds or securities and including trading or exchanging securities within an organized system. In particular, invention II discloses a virtual currency is not associated with any user of the system. Invention III has separate

utility such as determining a specific charge for goods/services. In particular, invention III discloses that a discount rate applicable to the virtual currency is adjusted to regulate trading. See MPEP § 806.05(d).

During a telephone conversation with James Woods on 5/1/02 a provisional election was made with traverse to prosecute the invention of I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Request For Continued Examination

The request filed on 2/19/02 for a Request For Continued Examination (CPA) under 37 CFR 1.1114 based on parent Application No. 09/382907 is acceptable and an RCE has been established. An action on the RCE follows.

Status of Claims

Claims 1-14 remain pending in this application. Claims 15-41 were not elected due to a restriction requirement.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7, 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "Hollywood Dollars" is unclear and makes the claims confusing. This term is not clearly defined in the specification and therefore renders the claim indefinite. For examination purposes, "Hollywood Dollars" will be interpreted as electronic currency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-11, 13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nymeyer (US Patent 3,581,072), and further in view of Fernholz (5,819,238).

As per claims 1, 9, 14, Nymeyer discloses:

Measuring an imbalance.../means for measuring an imbalance...(Col. 7, lines 64-74);

Computing a projected price movement.../means for computing a projected price movement (Col. 7, lines 71-74);

Setting a market price.../means for setting a market price ... (Abstract, lines 1-3);

Automatically generating additional buy orders.../means for automatically generating additional buy orders... (Col. 11, line 68-Col. 12, line 3).

Nymeyer fails to disclose the following, however Fernholz discloses:

Generating the electronic currency.../means for generating the electronic currency (Col. 12, lines 16-17, here Fernholz discloses the custodial bank holds electronic cash which is distributed for trade purposes).

Crediting/debiting.../means for crediting/debiting (Col. 12, lines 50-55).

It would have been obvious to one of ordinary skill in the art to generate electronic currency and to credit or debit the traders' accounts with electronic currency for executed buy/sell orders with the motivation of initiating and finalizing the trade.

As per claims 2, 10, Nymeyer fails to teach the following, however, Fernholz discloses:

Electronic currency...(Col 12, lines 16-17).

It would have been obvious to one of ordinary skill in the art to use electronic currency for trading instruments with the motivation of using compatible resources for trade purposes in a computerized environment.

As per claims 3, 11, Nymeyer discloses:

Further comprising exchanging the Hollywood dollars in the first or second trader's account.../further comprising means for exchanging the Hollywood dollars in the first or second trader's account ... (Col. 1, lines 12-29, wherein claim limitation is merely describing a trade).

As per claims 8, 13, Nymeyer discloses:

Wherein the additional buy orders or sell orders for the instrument are automatically generated at the market price...(Col. 7, lines 44-61).

Claims 4-7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nymeyer (US Patent 3,581,072), and further in view of Fernholz (5,819,238), and further in view of Stein, et al (US Patent 5,826,241).

As per claims 4-7, 12, neither Nymeyer or Fernholz disclose the following, however Stein, et al discloses:

Wherein the Hollywood dollars are exchanged at a currency exchange web site...via a secured communication.../further comprising purchasing goods or services using the Hollywood dollars.../wherein a request for the purchase is transmitted to the vendor's.../wherein the vendor debits the first or second trader's account in the Hollywood dollars ...via a secure communication...(Col. 9, lines 49-54).

It would have been obvious to one of ordinary skill in the art to request an exchange, to purchase goods, to request a purchase, and to debit accounts through a website on the Internet via secure communications with the motivation of executing financial transactions on the Internet using the most common tools in Internet technology, thereby making the most logical, safest purchases with low risk factors. Stein doesn't specifically state that the exchange is done on a web site, however he does disclose that the exchange is done on the Internet making the implementation through a web site obvious.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R.-B.
May 2, 2002


TARIQ R. HAFIZ
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